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## REMARKS

Claims 1-17 are pending in the application. By this Amendment, claim 1 has been amended to correct a minor clerical error and to more particularly point out and distinctly claim the invention. Applicants expressly reserve the right to pursue broader claims and/or to appeal any or all rejections.

To date, no Notice of Draftsperson's Patent Drawing Review has been received. Applicants respectfully request receipt of this document when it becomes available. Please note that the original drawings filed in the patent application are "formal" drawings.

### 35 U.S.C. § 102 Rejections

#### Claims 10, 11, 13, and 15-17

Claims 10, 11, 13, and 15-17 are rejected under 35 U.S.C. § 102(b) over Ishikawa (U.S. Patent No. 5,946,028). However, because Ishikawa fails to disclose all of the limitations of claims 10, 11, 13, and 15-17, it is respectfully submitted that Ishikawa cannot anticipate claims 10, 11, 13, and 15-17.

Specifically, claim 10 (and claims 11, 13, and 15-17 which depend from claim 10) recites:

A digital camera comprising:  
an image sensor disposed at a position at which an image is to be formed by a taking lens; and  
an optical element movable between an advanced position intersecting at an inclination the optical path from the taking lens to said image sensor, and a retracted position removed from the optical path,  
wherein said digital camera is controllable **under a first photographic mode wherein said optical element is set at the advanced position for photography**, and a second photographic mode wherein said optical element is set at the retracted position for photography, and the optical path lengths from the taking lens to said image sensor are equalized in the first photographic mode and the second photographic mode by

moving the taking lens in a direction along the optical axis of the taking lens. (Emphasis added).

Ishikawa discloses a camera having a taking lens and a mirror inclined at an angle to an optical axis of the taking lens. The mirror can be provided with a slit moving between a first position for monitoring mode where no image recording occurs and a second position for photographing where image recording is required (col. 3, lines 16-22). The mirror having a slit can be replaced with a half mirror or quick-return mirror (col. 3, lines 36-37). The present Office Action alleges that the monitoring mode discussed in Ishikawa constitutes a first photographic mode as claimed in claim 10. However, this allegation is respectfully traversed. It is pointed out that claim 10 specifically recites that the first photographic mode is “for photography” while Ishikawa explicitly states that “in a monitoring mode. ...no image recording (photographing) is required....” (Ishikawa, col. 3, lines 19-21). Thus, Ishikawa fails to disclose or suggest the first photographic mode claimed in claim 10. Therefore, since Ishikawa fails to disclose all of the limitations of claim 10, Ishikawa cannot anticipate claim 10, or claims 11, 13, and 15-17 which depend from claim 10.

Accordingly, it is respectfully requested that the rejection of claims 10, 11, 13, and 15-17 under 35 U.S.C. § 102(b) as being anticipated by Ishikawa, be reconsidered and withdrawn.

#### **Claims 1, 2, and 8**

Claims 1, 2, and 8 are rejected under 35 U.S.C. § 102(e) over Osawa (U.S. Patent No. 6,327,085 B1). However, because Osawa fails to disclose all of the limitations of claims 1, 2, and 8 as amended, it is respectfully submitted that Osawa cannot anticipate amended claims 1, 2, and 8.

Specifically, amended claim 1 (and claims 2 and 8 which depend from claim 1) recites:

A digital camera comprising:  
an image sensor disposed at a position at which an image is to be formed by a taking lens;  
a recorder for recording on a recording medium an image sensed by said image sensor in accordance with recording instructions;  
a semitransparent mirror which rotates about an axis in a direction perpendicular to the optical axis of the taking lens so as to move between **an advanced position intersecting at an inclination the optical path from the taking lens to the image sensor for photographing in a first photographic mode, and a retracted position removed from the optical path for photographing in a second photographic mode;** and  
an optical finder providing an image by directing the light reflected by said semitransparent mirror set at the advanced position from the taking lens to the eye of a user.

Thus, claim 1 as amended recites that the mirror moves between an advanced position for photographing in a first photographic mode and a retracted position for photographing in a second photographic mode.

Osawa discloses a camera having a quick-return mirror that moves between an advanced position for monitoring and auto-focus and a retracted position for photographing. (Osawa, col. 12, lines 49-54 and col. 12, line 63- col. 13, line 2). However, Osawa fails to disclose or suggest a photographing mode where photographing is performed with the mirror at the advanced position. Therefore, since Osawa fails to disclose all of the limitations of claim 1, Osawa cannot anticipate claim 1, or claims 2 and 8 which depend from claim 1.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, and 8 under 35 U.S.C. § 102(e) as being anticipated by Osawa et al, US 6,327,085, be reconsidered and withdrawn.

**35 U.S.C. § 103 Rejections**

**Claims 3-6**

Claims 3-6 are rejected under 35 U.S.C. § 103(a) over Osawa in view of Ishikawa. However, because the proposed combination of Osawa and Ishikawa fails to disclose or suggest all of the limitations of claims 3-6, the proposed combination of Osawa and Ishikawa cannot render obvious claims 3-6.

Specifically, claims 3-6 depend from claim 1, which as amended recites a mirror that moves between an advanced position for photographing in a first photographic mode and a retracted position for photographing in a second photographic mode.

As mentioned above, Osawa fails to disclose or suggest a photographing mode where photographing is performed with the mirror at the advanced position. Ishikawa is relied upon primarily for alleged disclosure of a mirror with a movable slit which can be replaced with a half mirror or quick return mirror. However, since Osawa is silent with respect to a photographing mode where photographing is performed with the mirror at the advanced position, the alleged teaching of a movable image sensor by Suzuki would fail to cure the deficiencies of Osawa in rendering obvious the invention of claim 1. Therefore, since the proposed combination of Osawa and Ishikawa fails to disclose or suggest all of the limitations of claim 1, the proposed combination of Osawa and Ishikawa cannot render obvious claim 1, or claims 3-6 which depend from claim 1.

Accordingly, it is respectfully requested that the rejection of claims 3-6 under 35 U.S.C. § 103(a) over Osawa in view of Ishikawa be reconsidered and withdrawn.

**Claim 7**

Claim 7 is rejected under 35 U.S.C. § 103(a) over Osawa in view of Togino (U.S. Patent No. 6,128,144). However, because the proposed combination of Osawa and Togino

fails to disclose or suggest all of the limitations of claim 7, the proposed combination of Osawa and Togino cannot render obvious claim 7.

Specifically, claim 7 depends from claim 1, which as amended recites a mirror that moves between an advanced position for photographing in a first photographic mode and a retracted position for photographing in a second photographic mode.

As mentioned above, Osawa fails to disclose or suggest a photographing mode where photographing is performed with the mirror at the advanced position. Togino is relied upon primarily for alleged disclosure of a photographic mode where a semitransparent mirror is set at an advanced position when recording, in support of which the Office Action cites Togino, fig. 60 and col. 53, lines 25-40. However, this allegation is respectfully traversed. First, the mirror shown in Togino, fig. 60 is only referred to as “a quick-return mirror 41” (Togino, col. 53, line 30). As such, there is no suggestion that the mirror in fig. 60 is even capable of transmitting any light. Second, there is no mention in Togino, particularly in the portion thereof cited by the Office Action, of the mirror remaining in the advanced position during photographing. Thus, it is respectfully submitted that Togino, like Osawa, fails to disclose or suggest a photographing mode where photographing is performed with a mirror at the advanced position. Therefore, since both Osawa and Togino fail to disclose or suggest a photographing mode where photographing is performed with a mirror at the advanced position, it follows that the proposed combination of Osawa and Togino likewise fails to disclose or suggest a photographing mode where photographing is performed with a mirror at the advanced position. Since the proposed combination of Osawa and Togino fails to disclose or suggest all of the limitations of claim 1, the proposed combination of Osawa and Togino cannot render obvious claim 1, or claim 7 which depends from claim 1.

Accordingly, it is respectfully requested that the rejection of claim 7 under 35 U.S.C. § 103(a) over Osawa in view of Togino be reconsidered and withdrawn.

**Claim 9**

Claim 9 is rejected under 35 U.S.C. § 103(a) over Osawa in view of Aoki '170 (U.S. Patent No. 4,553,170). However, because the proposed combination of Osawa and Aoki '170 fails to disclose or suggest all of the limitations of claim 9, the proposed combination of Osawa and Aoki '170 cannot render obvious claim 9.

Specifically, claim 9 depends from claim 1, which as amended recites a mirror that moves between an advanced position for photographing in a first photographic mode and a retracted position for photographing in a second photographic mode.

As mentioned above, Osawa fails to disclose or suggest a photographing mode where photographing is performed with the mirror at the advanced position. Aoki '170 is relied upon primarily for alleged disclosure of a photographic mode where a semitransparent mirror is set at a retracted position regardless of whether recording is instructed. However, since Osawa is silent with respect to a photographing mode where photographing is performed with the mirror at the advanced position, the alleged teaching of the retracted-mirror photographic mode by Aoki '170 would fail to cure the deficiencies of Osawa in rendering obvious the invention of claim 1. Therefore, since the proposed combination of Osawa and Aoki '170 fails to disclose or suggest all of the limitations of claim 1, the proposed combination of Osawa and Aoki '170 cannot render obvious claim 1, or claim 9 which depends from claim 1.

Accordingly, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. § 103(a) over Osawa in view of Aoki '170 be reconsidered and withdrawn.

**Claim 12**

Claim 12 is rejected under 35 U.S.C. § 103(a) over Ishikawa in view of Osawa. However, because the proposed combination of Ishikawa and Osawa fails to disclose or

suggest all of the limitations of claim 12, the proposed combination of Ishikawa and Osawa cannot render obvious claim 12.

Specifically, claim 12 depends from claim 10, which as pointed out above recites “a first photographic mode wherein said optical element is set at the advanced position for photography....”

As mentioned above, Ishikawa fails to disclose or suggest a photographing mode where an optical element is set at an advanced position for photography. As also pointed out above in connection with claim 1, Osawa fails to disclose or suggest a photographing mode with a mirror, or any optical element, set at the advanced position. Therefore, since both Ishikawa and Osawa fail to disclose or suggest a photographing mode where photographing is performed with a mirror at the advanced position, it follows that the proposed combination of Ishikawa and Osawa likewise fails to disclose or suggest a photographing mode where photographing is performed with a mirror at the advanced position. Therefore, since the proposed combination of Ishikawa and Osawa fails to disclose or suggest all of the limitations of claim 10, the proposed combination of Ishikawa and Osawa cannot render obvious claim 10, or claim 12 which depends from claim 10.

Accordingly, it is respectfully requested that the rejection of claim 12 under 35 U.S.C. § 103(a) over Ishikawa in view of Osawa be reconsidered and withdrawn.

#### **Claim 14**

Claim 14 is rejected under 35 U.S.C. § 103(a) over Ishikawa in view of Aoki ‘347 (U.S. Patent No. 5,920,347). However, because the proposed combination of Ishikawa and Aoki ‘347 fails to disclose or suggest all of the limitations of claim 14, the proposed combination of Ishikawa and Aoki ‘347 cannot render obvious claim 14.



Specifically, claim 14 depends from claim 10, which as pointed out above recites “a first photographic mode wherein said optical element is set at the advanced position for photography....”

As mentioned above, Ishikawa fails to disclose or suggest a photographing mode where an optical element is set at an advanced position for photography. Aoki '347 is relied upon primarily for alleged disclosure of a mirror that is raised and lowered by a movement other than rotation. However, since Ishikawa is silent with respect to a photographing mode where photographing is performed with the mirror at the advanced position, the alleged teaching of a mirror that is raised and lowered by a movement other than rotation by Aoki '347 would fail to cure the deficiencies of Ishikawa in rendering obvious the invention of claim 10. Therefore, since the proposed combination of Ishikawa and Aoki '347 fails to disclose or suggest all of the limitations of claim 10, the proposed combination of Ishikawa and Aoki '347 cannot render obvious claim 10, or claim 14 which depends from claim 10.

Accordingly, it is respectfully requested that the rejection of claim 14 under 35 U.S.C. § 103(a) over Ishikawa in view of Aoki '347 be reconsidered and withdrawn.

### **New Claims**

New claim 18 recites:

A digital camera comprising:

- an image sensor disposed at a position at which an image is to be formed by a taking lens;

- a recorder for recording on a recording medium the image sensed by said image sensor in accordance with recording instructions;

- a semitransparent mirror which rotates about an axis in a direction perpendicular to the optical axis of the taking lens so as to move between an advanced position intersecting at an inclination the optical path from the taking lens to the image sensor and a retracted position removed from the

optical path;

an optical finder providing an image by directing the light reflected by said semitransparent mirror at the advanced position from the taking lens to the eye of a user; and

a display portion which displays the image sensed by said image sensor, said display portion displaying the image which is formed at the image sensor with the light transmitted through the semitransparent mirror at the advanced position from the taking lens.

None of the references cited in the Office Action does disclose nor suggest the display portion displaying an image which is formed at the image sensor with the light transmitted through the semitransparent mirror at the advanced position from the taking lens as claimed in claim 18. Accordingly, new claim 18 is patentably distinct from the cited references. Claim 19 is dependent upon claim 18 and includes all limitations of claim 18. Therefore, claim 19 is also patentably distinct from the cited references.

New claim 20 recites:

A digital camera comprising:

an image sensor disposed at a position at which an image is to be formed by a taking lens; and

an optical element movable between an advanced position intersecting at an inclination the optical path from the taking lens to said image sensor, and a retracted position removed from the optical path,

wherein said digital camera is controllable under a first photographic mode wherein said optical element is set at the advanced position for photography, and a second photographic mode wherein said optical element is set at the retracted position for photography, and the optical path lengths from the taking lens to said image sensor are equalized in the first photographic mode and the second photographic mode by moving the image sensor.

As stated above, none of the cited references show or suggest a first photographic mode wherein said optical element is set at the advanced position for photography as claimed in claim 20. Accordingly, new claim 20 is patentably distinct from the cited references.

### **CONCLUSION**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.


This Amendment increases the number of independent claims by 2 from 2 to 4 (3 previously paid for) and increases the total number of claims by 3 from 17 to 20 (20 previously paid for), but does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$86.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Application No.: 09/669,118  
Amendment dated July 1, 2004  
Reply to Office Action of January 5, 2004

Any fee required for such Petition for Extension of Time, and any other fee required by this document, other than the issue fee, and not submitted herewith, should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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